

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Khalil Arar	Art Unit:	1637
Serial No.:	10/560,987	Examiner:	Heather Calamita
Filed:	April 6, 2007	Conf. No.:	9438
For:	FLUOROGENIC NUCLEIC ACID PROBES INCLUDING LNA FOR METHODS TO DETECT AND/OR QUANTIFY NUCLEIC ACID ANALYTES		

July 24, 2009

RESPONSE TO RESTRICTION REQUIREMENT

TO THE COMMISSIONER FOR PATENTS,

SIR:

In response to the Restriction Requirement dated May 28, 2009, Applicant makes the following election and response. A petition pursuant to 37 C.F.R. 1.136(a) to extend the time period for response by one month, from June 28, 2009 through and including July 28, 2009, is submitted herewith along with authorization for payment of the appropriate fee. Applicant believes that no additional fee is due, however the Commissioner is authorized to withdraw any additional fees that may be required or credit any overpayment to Deposit Account 50-1662.

The Office has divided the claims of the invention into two groups: Group I (claims 1-10) drawn to a nucleic acid probe or pair of probes, and Group II (claims 11-38) drawn to a method for detecting or quantifying a nucleic acid analyte.

Applicant elects, with traverse, Group II, encompassing claims 11-38. In making this election, Applicant reserves all rights to any elected or non-elected subject matter from the originally filed patent application. As such, Applicant reserves all right in

Group I, claims 1-10, including the right to file divisional and/or continuation applications thereto.

Applicant respectfully traverses the restriction requirement as all of the pending claims have one or more shared points of novelty and collectively refer to a single invention. In particular, Applicant notes that a key feature of the claims in Groups I and II is the fluorescently labeled nucleic acid probe that comprises LNA moieties.

According to 35 U.S.C. § 121, a restriction is proper only if there are at least two independent and distinct inventions. Furthermore, "[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions."¹ The claims of Groups I and II are related in that they pertain to LNA-containing fluorogenic nucleic acid probes. Applicant further respectfully submits that the extent of any divergence among the claims reflects the scope of the Applicants' invention and does not constitute a claim to a separate invention. Any search of the prior art and examination involving the claims of Group I, therefore, will necessarily co-extend with the search and examination of the claims of Group II, and vice versa. Thus, all claims share a common point of patentability, can be searched in a single search, and the combined search will not constitute an undue burden on the Examiner. Consequently, the restriction requirement should be withdrawn and all pending claims should be examined together. Subject to the foregoing traverse, Applicants hereby elect the claims of **Group II** to facilitate prosecution.

The Office is also requiring an election of several species to which the claims shall be restricted if no generic claim is finally held to be allowable. With regard to Group II, the Office has identified three species for election. Namely: 1) type of fluorescent dye composition; 2) type of interaction to cause a fluorescence change, and 3) type of donor/acceptor pair.

Applicant elects the following species:

- 1) donor and acceptor fluorescent dyes (i.e., claims 13 and 26).

¹ MPEP § 803.

- 2) hybridization (i.e., claim 15 and 31)
- 3) fluorescein and LC Red 540 or LC Red 705 (i.e., claim 29)

In summary, upon election of the above-noted species, the elected Group II reads on claims 11, 13-15, 17-19, 22-24, 26, 27, and 29-38.

The Examiner is invited to contact the undersigned practitioner should any issues remain unresolved.

Respectfully submitted,
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